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PATENT
Customer No. 22,852
Attorney Docket No. 05725.0875-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	
)	
Alaine BETHUNE et al.)	Group Art Unit: 1771
)	
Application No.: 09/824,244)	
)	Examiner: A. Sperty
Filed: April 3, 2001)	
)	
For: OBJECT HAVING A DECORATIVE)	Confirmation No.: 8888
PATTERN AND METHOD OF APPLYING)	
THE DECORATIVE PATTERN)	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants submit this Reply Brief in response to the Examiner's Answer dated January 13, 2005. A Request for Oral Hearing is being concurrently filed with this Reply Brief.

If there are any fees due in connection with the filing of this Reply Brief, which are not enclosed herewith, please charge such fees to our Deposit Account No.

06-0916.

I. Status of Claims

Claims 1-25 are pending in this application. Claims 16-24 have been withdrawn from consideration as being drawn to non-elected subject matter. Claims 1-15 and 25 have been finally rejected in the final Office Action dated June 2, 2004 and the rejections applied to those claims are at issue in this appeal.

II. Grounds of Rejection to be Reviewed on Appeal

In the Examiner's Answer, the Examiner withdrew: (1) the rejection of claim 25 under 35 U.S.C. § 112, second paragraph, (Examiner's Answer, p. 6); and (2) the rejection of claims 1-15 and 25 under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,546,751 to Jaeger (Examiner's Answer, p. 12).

Consequently, the outstanding grounds of rejection to be reviewed on this Appeal are as follows:

- Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.
- Claims 1-3, 8-12, 14-15, and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,505,320 to Burns et al. ("Burns").
- Claims 1-15 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over German Patent Publication No. DE 3704403 to Mitsubishi Kinzoku K.K. ("Mitsubishi") and German Patent Publication No. DE 3030403 to Rodi & Wienenberger AG ("Rodi").

III. Response to Comments in the Examiner's Answer Regarding the Brief's Summary of Claimed Subject Matter

In the Examiner's Answer, the Examiner alleges that that "[t]he summary of invention contained in the brief is deficient because the description and the included drawings are inconsistent with each other and with the originally filed specification and drawings." Examiner's Answer, p. 2. The Examiner then provides four arguments setting forth numerous allegations relating to the alleged deficiency. As detailed below, the Examiner's allegations concerning the Appeal Brief's summary of claimed subject matter section are completely baseless and thus unsupportable.

The Examiner's first argument is that "the decorative pattern 6 of the drawings currently in the application is different from the decorative pattern 6 of the description in the Appeal Brief." The Examiner also alleges that "the changed designation of elements changes the invention" and that "[c]hanging the elected invention is impermissible." Examiner's Answer, pp. 2-3. In making these allegations, however, the Examiner does not provide any explanation or plausible reasoning as to how the description of the decorative pattern in the Appeal Brief is allegedly different from the description and/or the drawings of the decorative pattern in the originally-filed application.

Appellants submit that, contrary to the Examiner's allegations, the designation of the decorative pattern 6 and every other element in annotated Figs. 2B and 2C of the Appeal Brief is entirely consistent with the specification and the drawings of the originally-filed application. Annotated Figs. 2B and 2C of the Appeal Brief merely facilitate further explaining exemplary embodiments having first and second metallic coatings. Those annotated drawings do not deviate from the decorative pattern disclosed in the originally-filed application.

For example, in the Appeal Brief's description of the annotated drawings, Appellants referred to supporting passages from the originally-filed application and also provided page and line citations for those passages. The Examiner has not even attempted to point out any inconsistency in that description.

Worth noting is the Examiner's allegation that she has interpreted the claims "according to the drawings submitted with the application." Examiner's Answer, p. 2. The record clearly indicates just the opposite. For example, in the June 2, 2004 Office Action, the Examiner objected to original Figs. 2B and 2C for an alleged lack of clarity associated with the designation of decorative pattern 6. Appellants do not understand how it is possible for the Examiner to now take the position that she has interpreted the claims "according to the drawings" after she previously alleged those drawings lacked clarity. More importantly, if the Examiner has interpreted the claims as being limited to the exemplary embodiments illustrated in the application drawings, such an interpretation is clearly improper. Whatever the Examiner's interpretation of the claims may be, such interpretation has not been fully conveyed to Appellants or clearly made of record, and is not supported by the original disclosure.

The Examiner's second argument is that "the shading of the drawings in the Appeal Brief indicates 10, 11, 12 as one coating, with a second coating made of two crosshatched layers in Fig 2B and one crosshatched layer in Fig 2C formed separately from layers 10, 11 and 12." Examiner's Answer, p. 3. (Emphasis in original).

Appellants disagree with this baseless argument because, contrary to the Examiner's allegation, the shading and crosshatching of annotated Figs. 2B and 2C does not "indicate" that the shaded and crosshatched portions are formed separately,

and, even if they did, such an indication would be objectionable because “separately” forming is not at issue in the present appeal. As mentioned above, annotated Figs. 2B and 2C of the Appeal Brief facilitate further explaining exemplary embodiments of the originally-filed application. Those drawings were not intended to provide any teaching of whether or not portions are formed separately or together. The Examiner’s second argument appears to be based on speculation and a clear misunderstanding of the disclosure and claims.

The Examiner’s third argument is that “the drawings ... do not correlate with the text of the Appeal Brief.” Examiner’s Answer, p. 4. In particular, the Examiner alleges that “the shading and crosshatching of the Appeal Brief drawings do not indicate that the metallic coating B comprises uncovered layers 10 and 11.”

Appellants disagree. Appellants do not understand the basis for this argument given that annotated Figs. 2B and 2C are consistent with their description in the Appeal Brief. That is, contrary to the Examiner’s allegations, annotated Fig. 2B clearly illustrates a second metallic coating (i.e., cross-hatched portions designated with reference character “B”) comprising two (e.g., a maximum of $n-1$; at least one layer less than the first metallic coating) layers (i.e., a layer 10 of nickel and a layer 11 of copper). Similarly, Fig. 2C clearly illustrates a second metallic coating B comprising one layer (i.e., the layer 10 of nickel). Thus, Appellants submit that the annotated drawings in the Appeal Brief are consistent with their description in the Appeal Brief.

The Examiner’s final argument is that “the text of the Appeal Brief (page 9, lines 15-20; page 12, last paragraph, with respect to claim 25) again seems to indicate that 10 and 11 are included in both the first metallic coating and the second metallic

coating.” Examiner’s Answer, p. 4. In particular, the Examiner alleges that “layers 10, 11, and 12 may either be in the first metallic coating or the second metallic coating, but not in both.”

Appellants submit that this is one of many clear illustrations of how the Examiner has completely failed to appreciate the fact that an applicant is entitled to be his or her own lexicographer in choosing claim terminologies to define his or her invention. In the present case, Appellants chose to use the terms “first metallic coating,” “second metallic coating,” and “layer(s)” consistently throughout the specification and the claims.

According to their meanings, it is clear that a coating can comprise one or more layers, that two different coatings can share one or more layers in common, and that there is no requirement that the coatings must be separately formed.

For at least the reasons set forth above, Appellants submit that the Appeal Brief’s Summary of Claimed Subject Matter is accurate and that the Examiner’s allegation about its deficiency should be disregarded.

IV. Response to Comments in the Examiner’s Answer Regarding the Grouping of Claims

The Examiner asserts that “[t]he rejection of claims 1-15 stand or fall together because appellant’s brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof.” Examiner’s Answer, page 4. Appellants disagree.

The grouping of claims requirement set forth in former Rule 192(c)(7) has been removed, effective September 13, 2004, and the general purpose served by former Rule 192(c)(7) is now addressed in § 41.37(c)(1)(viii). See 69 Fed. Reg. 49962 (Aug. 12, 2004). Thus, the Examiner’s assertion is erroneous and should be disregarded.

V. Response to Comments in the Examiner's Answer Regarding Claim Rejections

A. 35 U.S.C. § 112, Second Paragraph, Rejection

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner alleges that the term “partially delimiting” is unclear. More specifically, the Examiner alleges that “[w]ithout knowing the orientation of the coatings and layers, it is unclear in what way the first metallic film ‘partially delimits’ a decorative pattern.” Examiner’s Answer, pp. 5-6. Appellants disagree and submit that, contrary to the Examiner’s allegations, the claim language fully satisfies the requirements of 35 U.S.C. § 112, second paragraph, for at least the same reasons set forth in the Appeal Brief. Appeal Brief at pp. 15-17.

In response to arguments presented in the Appeal Brief, the Examiner continues to allege that “Applicant has not explained which coating is closer to the support and which is further away.” The Examiner then alleges that “Applicant ... refuses to elaborate ... to answer the examiner’s question regarding the orientation of the coatings.” Examiner’s Answer, p. 8.

Appellants submit that an explanation of so-called “orientation of the coatings” is not necessary simply because such “orientation of the coatings” is not present in the claims. In fact, such “orientation of the coatings” is not even relevant to understanding the scope of the claims.

Apparently, the Examiner’s erroneous belief that the “orientation of the coatings” is required to understand the claimed subject matter is a direct result of the Examiner’s misinterpretation of the claims. In particular, the Examiner has completely misinterpreted the relationship between the recited first and second metallic coatings

and the recited layers. Appellants have made numerous attempts (e.g., a personal interview with the Examiner) to explain that the claims and specification consistently use terminology such as “first metallic coating,” “second metallic coating,” “layer(s),” “first metallic being formed of at least n superposed layers of metal” and “second metallic coating being formed of a maximum of n-1 layers of metal.” Nevertheless, the Examiner continues to insist that the claims are unclear without providing any convincing evidence or reasoning.

The Examiner further alleges that “[c]larifying which layer is closest to the support would allow one of ordinary skill in the art to know whether the first metallic coating surrounds an area in which the second metallic coating is deposited, or if the first metallic coating is provided on an area and is surrounded by the second metallic coating.” Examiner’s Answer, p. 9.

In making this allegation, the Examiner is apparently requesting that Appellants redraft the claims according to the Examiner’s erroneous interpretation of the claim terms. Moreover, the Examiner is apparently attempting to force Appellants to unnecessarily and unduly narrow the claim scope. Appellants submit that breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). The claims clearly embrace the scope of the claimed subject matter, and thus there is no reason to amend the claims as proposed by the Examiner.

As fully explained in the Appeal Brief, the term “partially delimited” creates no ambiguity concerning the scope of the claims, and the claims clearly comply with 35 U.S.C. 112, second paragraph. Accordingly, Appellants submit that the rejection of claims 1-15 under 35 U.S.C. § 112, second paragraph, should be reversed.

B. 35 U.S.C. § 102(b) Rejection Based on Burns

Claims 1-3, 8-12, 14-15, and 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Burns. Appellants disagree and submit that Burns does not anticipate independent claims 1 and 25 for at least all of the reasons set forth in the Appeal Brief at pages 18-25.

Rather than responding to the Appellants' arguments presented in the Appeal Brief, the Examiner's Answer merely repeats the prior rejection statement from the December 23, 2003 Office Action and sets forth a general allegation that "[a]ccording to the examiner's interpretation of the claims, Burns anticipates the invention." Examiner's Answer, p. 11. Notwithstanding that general allegation, the Examiner has not clearly communicated how she has interpreted the claims and how she is alleging Burns allegedly corresponds to the claims as construed. For example, the prior rejection statement in the December 23, 2003 Office Action lacks any sufficient explanation of how portions of the disclosure of Burns might allegedly correspond to certain claim elements and limitations. That is, the rejection statement is essentially paraphrased from the Appellants' claims without having a sufficient indication of how the claims have been rejected. Stated simply, Burns does not teach or suggest all of the features of claims 1 and 25, for at least the reasons set forth in the Appeal Brief.

Accordingly, Appellants submit that the rejection of claims 1-3, 8-12, 14-15, and 25 under 35 U.S.C. § 102(b) is erroneous and should be reversed.

C. 35 U.S.C. § 103(a) Rejections Based on Mitsubishi and Rodi

Claims 1-15 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mitsubishi and Rodi. Appellants disagree with that rejection and

submit that, for at least the reasons set forth in the Appeal Brief, a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established by the Examiner. For example, the Examiner failed to provide sufficient evidence to show: (1) that each of the prior art references allegedly teaches or suggests all the claim elements; (2) that there is some alleged suggestion or motivation to modify the reference; and (3) that there is an alleged reasonable expectation of success.

In the Examiner's answer, without substantively responding to the Appellants' arguments presented in the Appeal Brief, the Examiner continues to attempt to shift her initial burden of proving a *prima facie* case to Appellants. As fully discussed in the Appeal Brief, such an attempt at shifting the initial burden of proof is clearly erroneous and contrary to the well-settled precedent established by the Board and the Federal Circuit.

Accordingly, Appellants submit that the rejection of claims 1-15 and 25 under 35 U.S.C. § 103(a) is erroneous and should be reversed.

VI. Conclusion

For the reasons set forth above, Appellants maintain that pending claims 1-15 and 25 fully comply with 35 U.S.C. § 112, second paragraph, and are patentable over the references. The Board is therefore respectfully requested to reverse the

outstanding rejections under 35 U.S.C. §§ 112, second paragraph, 102(b), and 103(a),
so that claims 1-15 and 25 may be allowed.

Respectfully submitted,

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Dated: March 11, 2005

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